


NAGACO.215A



DAL IFW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                |  |   |   |
|----------------|--|---|---|
| Applicants     | : Staimer, et al.  | ) | I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on |
| Appl. No.      | : 10/828,732   | ) |   |
| Filed          | : April 21, 2004   | ) |   |
| For            | : OPTICAL BIO-DISKS<br>INCLUDING SPIRAL FLUIDIC<br>CIRCUITS FOR<br>PERFORMING ASSAYS | ) |   |
| Examiner       | : Unknown  | ) |   |
| Group Art Unit | : 1744   | ) |   |
|                |  |   | 2-28-05<br>(Date)   |
|                |  |   | <br>Russell M. Jeide, Reg. No. 54,198  |

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. 1.47(A)

Mail Stop Missing Parts  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Request is in response to the Decision Refusing Status under 37 C.F.R. 1.47(a), dated February 11, 2005.

**Appl. No.** : 10/828,732  
**Filed** : April 21, 2004

### **STATEMENTS OF FACTS**

1. On April 21, 2004, Petitioner filed the above-identified application without an executed oath or declaration.
2. On June 29, 2004, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application, stating that the oath or declaration was missing, and requiring a surcharge for its late filing.
3. On November 1, 2004 (certificate of mailing October 28, 2004), petitioner submitted a petition with an executed Declaration executed by four joint inventors, specifically, Norbert Staimer, YihFar Chen, James Norton and Joy Jison. The Declaration that was executed by each of Messrs. Staimer, Chen, Norton and Jison also listed Johnny C. Mounphoxay as an inventor and included a signature block for him. However, the signature block for Mr. Mounphoxay is on the last page of the Declaration (page 3) and was inadvertently omitted from the Declaration filed on November 1, 2004. Attached hereto as Exhibit A is a true and correct copy of the Declaration that was sent to each of the five listed inventors.
4. Attached hereto as Exhibit B are complete copies of the declarations that were signed by Messrs. Staimer, Chen, Norton and Jison, each listing Mr. Mounphoxay as an inventor.

### **DISCUSSION**

Attached hereto as Exhibit C is a Declaration of Russell Jeide in Support of Request For Reconsideration Of Petition Under 37 C.F.R. 1.47(a).

In view of the above-listed facts that are confirmed in the attached Declaration of Russell Jeide, Applicant respectfully submits that Mr. Mounphoxay was properly listed on the Declaration executed by Messrs. Staimer, Chen, Norton, and Jison. Petitioner respectfully asserts that the Petition filed on November 1, 2004 complies with 37 C.F.R. 1.63 and requests reconsideration of the November 1, 2004 Petition.

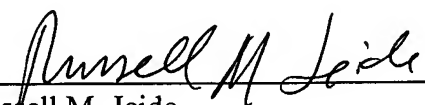
**Appl. No.** : 10/828,732  
**Filed** : April 21, 2004

If there are any obstacles to a prompt approval of this petition, the Patent and Trademark Office is invited to call the undersigned attorney.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2-28-05

By:   
Russell M. Jeide  
Registration No. 54,198  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550

1281136\_1  
022805

**DECLARATION - USA PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS; the specification of which was filed on April 21, 2004, as Application Serial No. 10/828,732.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim the benefit under Title 35, United States Codes § 119(e) of any United States provisional application(s) listed below.

Application No.: 60/464869

Filing Date: April 23, 2003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

-----  
Full name of first inventor: **Norbert Staimer**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 21141 Canada Road, #12E, Lake Forest, CA 92630

Citizenship: Germany

Mailing Address: Same

Full name of second inventor: **YihFar Chen**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 205 Ku-Shan 2<sup>nd</sup> Road, Kaohsing City, Taiwan 80446

Citizenship: R.O.C. Taiwan

Mailing Address: Same

Full name of third inventor: **James R. Norton**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 19321 Fisher Lane, Santa Ana, CA 92705

Citizenship: U.S.A.

Mailing Address: Same

Full name of fourth inventor: **Jay O.C. Jison**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 24345 Marquis Court, Laguna Hills, CA 92653

Citizenship: Philippines

Mailing Address: Same

Full name of fifth inventor: **Johnny C. Mounphoxay**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 2251 W. Falmouth Avenue, Anaheim, CA 92801

Citizenship: U.S.A.

Mailing Address: Same

---

Send Correspondence To:  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
**Customer No. 20,995**

S:\DOCS\RMJ\RMJ-3665.DOC:gem060404



**DECLARATION IN SUPPORT OF REQUEST FOR RECONSIDERATION OF  
PETITION UNDER 37 C.F.R. 1.47(A)**

I, Russell M. Jeide, hereby declare that, to the best of my knowledge, information, and belief, the following is true, accurate, and correct:

- 1) I am an associate attorney at Knobbe, Martens, Olson & Bear, LLP ("KMOB") and help coordinate prosecution of patent matters assigned to our client, Nagaoka and Co., LTD ("Nagaoka").
- 2) On April 21, 2004, Petitioner filed U.S. Patent Application No. 10/828,732 without an executed oath or declaration.
- 3) On June 29, 2004, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application, stating that the oath or declaration was missing, and requiring a surcharge for its late filing.
- 4) On November 1, 2004 (certificate of mailing October 28, 2004), petitioner submitted a petition with an executed Declaration executed by four joint inventors, specifically, Norbert Staimer, YihFar Chen, James Norton and Joy Jison. The Declaration that was executed by each of Messrs. Staimer, Chen, Norton and Jison also listed Johnny C. Mounphoxay as an inventor and included a signature block for him. However, the signature block for Mr. Mounphoxay is on the last page of the Declaration (page 3) and was inadvertently omitted from the Declaration filed on November 1, 2004. Exhibit A of the Request For Reconsideration Of Petition Under 37 C.F.R. 1.47(a) filed herewith is a true and correct copy of the Declaration that was sent to each of the five listed inventors.
- 5) Exhibit B of the Request For Reconsideration Of Petition Under 37 C.F.R. 1.47(a) filed herewith contains complete copies of the declarations that were signed by Messrs. Staimer, Chen, Norton and Jison, each listing Mr. Mounphoxay as an inventor.

Signature:

Russell M. Jeide  
(Russell M. Jeide)

Date:

2-28-05

**DECLARATION - USA PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled **OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS**; the specification of which was filed on April 21, 2004, as Application Serial No. 10/828,732.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim the benefit under Title 35, United States Codes § 119(e) of any United States provisional application(s) listed below.

Application No.: 60/464869

Filing Date: April 23, 2003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first inventor: **Norbert Staimer**

Inventor's signature *N. Staimer*

Date July 10, 2004

Residence: 21141 Canada Road, #12E, Lake Forest, CA 92630

Citizenship: Germany

Mailing Address: Same



Full name of second inventor: **YihFar Chen**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 205 Ku-Shan 2<sup>nd</sup> Road, Kaohsing City, Taiwan 80446

Citizenship: R.O.C. Taiwan

Mailing Address: Same

Full name of third inventor: **James R. Norton**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 19321 Fisher Lane, Santa Ana, CA 92705

Citizenship: U.S.A.

Mailing Address: Same

Full name of fourth inventor: **Jay O.C. Jison**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 24345 Marquis Court, Laguna Hills, CA 92653

Citizenship: Philippines

Mailing Address: Same

Full name of fifth inventor: **Johnny C. Mounphoxay**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 2251 W. Falmouth Avenue, Anaheim, CA 92801

Citizenship: U.S.A.

Mailing Address: Same

---

Send Correspondence To:  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
**Customer No. 20,995**

S:\DOCS\RMJ\RMJ-3665.DOC:gem060404

---

**DECLARATION - USA PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS; the specification of which was filed on April 21, 2004, as Application Serial No. 10/828,732.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim the benefit under Title 35, United States Codes § 119(e) of any United States provisional application(s) listed below.

Application No.: 60/464869

Filing Date: April 23, 2003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

-----  
Full name of first inventor: **Norbert Staimer**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 21141 Canada Road, #12E, Lake Forest, CA 92630

Citizenship: Germany

Mailing Address: Same

BEST AVAILABLE COPY

Page 2

Attorney's Docket No. NAGACO.215A

Full name of second inventor: YihFar Chen

Inventor's signature Yih far Chen

Date 2004-09-16

Residence: 205 Ku-Shan 2<sup>nd</sup> Road, Kaohsing City, Taiwan 80-46

Citizenship: R.O.C. Taiwan

Mailing Address: Same

Full name of third inventor: James R. Norton

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 19321 Fisher Lane, Santa Ana, CA 92705

Citizenship: U.S.A.

Mailing Address: Same

Full name of fourth inventor: Jay O.C. Jison

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 24345 Marquis Court, Laguna Hills, CA 92653

Citizenship: Philippines

Mailing Address: Same

Full name of fifth inventor: **Johnny C. Mounphoxay**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 2251 W. Falmouth Avenue, Anaheim, CA 92801

Citizenship: U.S.A.

Mailing Address: Same

---

Send Correspondence To:  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
**Customer No. 20,995**

S:\DOCS\RMJ\RMJ-3665.DOC:gem060404

---

**DECLARATION - USA PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS; the specification of which was filed on April 21, 2004, as Application Serial No. 10/828,732.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim the benefit under Title 35, United States Codes § 119(e) of any United States provisional application(s) listed below.

Application No.: 60/464869

Filing Date: April 23, 2003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

-----

Full name of first inventor: **Norbert Staimer**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 21141 Canada Road, #12E, Lake Forest, CA 92630

Citizenship: Germany

Mailing Address: Same

Page 2

Attorney's Docket No. NAGACO.215A

---

Full name of second inventor: **YihFar Chen**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 205 Ku-Shan 2<sup>nd</sup> Road, Kaohsing City, Taiwan 80446

Citizenship: R.O.C. Taiwan

Mailing Address: Same

Full name of third inventor: **James R. Norton**

Inventor's signature James R. Norton

Date 23 October 2004

Residence: 19321 Fisher Lane, Santa Ana, CA 92705

Citizenship: U.S.A.

Mailing Address: Same

Full name of fourth inventor: **Jay O.C. Jison**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 24345 Marquis Court, Laguna Hills, CA 92653

Citizenship: Philippines

Mailing Address: Same

Full name of fifth inventor: **Johnny C. Mounphoxay**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 2251 W. Falmouth Avenue, Anaheim, CA 92801

Citizenship: U.S.A.

Mailing Address: Same

---

Send Correspondence To:  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
**Customer No. 20,995**

S:\DOCS\RMJ\RMJ-3665.DOC:gem060404



---

**DECLARATION - USA PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS; the specification of which was filed on April 21, 2004, as Application Serial No. 10/828,732.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim the benefit under Title 35, United States Codes § 119(e) of any United States provisional application(s) listed below.

Application No.: 60/464869

Filing Date: April 23, 2003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

-----  
Full name of first inventor: **Norbert Staimer**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 21141 Canada Road, #12E, Lake Forest, CA 92630

Citizenship: Germany

Mailing Address: Same

Page 2

Full name of second inventor: YihFar Chen

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 205 Ku-Shan 2<sup>nd</sup> Road, Kaohsing City, Taiwan 80446

Citizenship: R.O.C. Taiwan

Mailing Address: Same

Full name of third inventor: James R. Norton

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 19321 Fisher Lane, Santa Ana, CA 92705

Citizenship: U.S.A.

Mailing Address: Same

Full name of fourth inventor: Jay O.C. Jison

Inventor's signature  \_\_\_\_\_

Date 10/10/04 \_\_\_\_\_

Residence: ~~24345 Marquis Court, Laguna Hills, CA 92653~~  
27 MALLORN DR. , ALISO VIEJO , CA 92656

Citizenship: Philippines

Mailing Address: ~~Same~~ 27 MALLORN DR.  
ALISO VIEJO , CA 92656

BEST AVAILABLE COPY

Full name of fifth inventor: **Johnny C. Mounphoxay**

Inventor's signature \_\_\_\_\_

Date \_\_\_\_\_

Residence: 2251 W. Falmouth Avenue, Anaheim, CA 92801

Citizenship: U.S.A.

Mailing Address: Same

---

Send Correspondence To:  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
**Customer No. 20,995**

S:\DOCS\RMJ\RMJ-3665.DOC:gem060404